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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,029	09/07/2005	Oleg Stenzel	264626US0PCT	8401
22850 7590 12/31/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HANOR, SERENA L	
			ART UNIT 4116	PAPER NUMBER
			NOTIFICATION DATE 12/31/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-4, drawn to a precipitated silica.

Group II, claim(s) 5-13, drawn to a process for preparing precipitated silica.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: precipitated silica is known in the art.

Unity exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding claimed technical features. The express "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art." (Rule 13.2). The question of unity of invention has been reconsidered retroactively by the examiner in view of the search performed; a review of US 5,705,137 (hereafter, US'137) makes it clear that the claimed species is not novel over the prior art (the instantly claimed compounds). US'137 is drawn to a

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precipitated silica with a BET surface area of 30-350 m<sup>2</sup>/g, a CTAB surface area of 30-350 m<sup>2</sup>/g, a DBP number of 150-300 ml/(100 g), and a Sears number V<sub>2</sub> of 6-20 ml/(5 g) (col. 2 lines 12-23). Furthermore, this reference appears to demonstrate that the technical feature (i.e. precipitated silica) does not define a contribution which each of the inventions, considered as a whole, makes over the prior art. Thus, lack of unity becomes apparent “a posteriori” after taking the prior art into consideration. Accordingly, the prior art of the record supports restriction of the claimed subject matter in to the groups as mentioned immediately above.

#### ***Election of Species***

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

4. In order for more than one species to be examined, the appropriate additional examination fees must be paid. The species are as follows:

- A. The same concentration of acidifier added in steps b and d.  
A different concentration of acidifier added in steps b and d.
- B. The same rate of addition of acidifier added in steps b and d.  
A different rate of addition of acidifier added in steps b and d.
- C. The same concentration of water added in steps b and d.  
A different concentration of water added in steps b and d.
- D. The same rate of addition of water added in steps b and d.  
A different rate of addition of water added in steps b and d.
- E. Granulated precipitated silica.  
Ungranulated precipitated silica.

5. The claims are deemed to correspond to the species listed above in the following manner:

- A. Claims 7-9
- B. Claims 7-9
- C. Claims 7-9
- D. Claims 7-9
- E. Claim 13

The following claim(s) are generic: Claim 6.

6. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: same and different and granulated and ungranulated have opposite definitions, and applicant cannot be his/her own lexicographer to change the definition of these words to mean something other than the commonly accepted meanings.

7. Unity exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding claimed technical features. The express "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art."(Rule 13.2).

Lack of unity of invention may be directly evident "a priori," that is, before considering the claims in relation to any prior art, or may only become apparent "a posteriori," that is, after taking the prior art into consideration. For example, independent

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claims to A + X, A + Y, X + Y can be said to lack unity a priori as there is no subject matter common to all claims. In the instant case, the claims are directed to the same and different rates of addition of water and acidifier, the same and different concentrations of water and acidifier, and granulated and ungranulated precipitated silica, where each species do not share common feature(s).

Therefore, the prior art of the record supports restriction in to the groups as mentioned immediately above.

### ***Telephone Election***

8. A telephone call was made to Mr. Surinder Sachar on 12/12/2007 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

### ***Joint Inventors***

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Rejoining Practice***

10. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Conclusion***

10. Claims 1-13 are subject to a Restriction Requirement.

11. Upon the election of Group II, Claims 5-13, Claims 6-9 and 13 are subject to an Election of Species Requirement.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SERENA L. HANOR whose telephone number is (571)270-3593. The examiner can normally be reached on Monday - Thursday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Supervisory Patent Examiner, Art Unit 4116